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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,430	03/24/2004	Roberto Lopez	23185.00	4262

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EXAMINER
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VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,430	<b>Applicant(s)</b> LOPEZ, ROBERTO	
	<b>Examiner</b> Frank Vanaman	<b>Art Unit</b> 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Status of Application**

1. Applicant's amendment, filed Feb 27, 2006 has been entered in the application. Claims 12-19 are pending, previously submitted claims 1-11 now being canceled.

### **Claim Objections**

2. Claim 12 is objected to for the following informality: in claim 12, line 7, there appears to be a word missing between "to" and "back".
3. Appropriate correction is required.

### **Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 12-14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. (US 6,491,315, cited by applicant) in view of Duerkob (US 4,954,808). Hagen et al. teach a step bar for a vehicle, including a tongue (32) for attachment to a receiver hitch connected to a back wall (30) of a tubular bar (12) which extends perpendicularly from the tongue in left and right directions, the bar including a front wall (14), with a plurality of signal lamps (28) including a left-most lamp and a right-most lamp provided in the wall, which may be connected to a brake light circuit of a vehicle, through wiring which leads to a connector (42) which mates with a standardized connector on the vehicle (col. 3, lines 35-36), the step being provided with a non-slip surface (20, 26) on the top of the bar. The reference to Hagen fails to teach the width of the front wall being greater than that of the top wall. The adjustment of relative sizes of elements already taught by the prior art is well known in the mechanical areas, and in the instant case, it would have been obvious to one of ordinary skill in the art at the time of the invention to increase the width of the front wall to be greater than that of the top wall for the purpose of accommodating larger lamps or lamp faces, thus increasing the relative size of the signaling area. The reference to Hagen et al. fails to teach left and right lamps which are connected to left and right turn signal circuits of the vehicle. Duerkob teaches that it is old and well known to provide a signal lamp device (1) with

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left and right signal lamps connected to left and right turn signal circuits (e.g., 7, 9), in addition to a brake light circuit (e.g., 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide at least left and right lamps of the step taught by Hagen et al. with connections to respective turn signal circuits as taught by Duerkob, for the purpose of providing further warning (i.e., turns as well as braking) to following vehicles.

As regards claims 18 and 19, the reference to Hagen et al. as modified by Duerkob fails to teach a particular dimension to the tubular structure of the step, however sizing of an already taught element to make use of commonly available structural materials is very well known in the manufacturing arts, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a 2 x 3 or 2 x 4 tubing size for the purpose of using a stock tubing material, saving manufacturing costs.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Duerkob and Mueller (US 6,170,842). The references to Hagen et al. and Duerkob are discussed above and fail to teach the tread material as being diamond plate. Mueller teaches a step element for use on a vehicle which includes a tread portion formed from diamond plate material (figure 2, 15b). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the tread portion of the step bar of Hagen et al. as modified by Duerkob with a diamond plate tread portion as taught by Mueller for the purpose of providing a more durable step surface than may be had from a resilient element.

7. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Duerkob and Cipolla (US 6,769,704). The reference to Hagen et al. as modified by Duerkob is discussed above and fails to teach the ends of the bar as extending at ~~about a 45 degree~~<sup>an</sup> angle, and the provision of plastic end caps at the ends of the tube. Cipolla teaches a step bar for attachment to a trailer hitch, which includes a step body (11, 12) which includes left and right ends (12a, 12b) which extend

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in an angled manner with respect to the central step portion, which further includes cap elements (not referenced, see ends of 12a, 12b). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the ends of the bar taught by Hagen et al. as modified by Duerkob with angled terminations as taught by Cipolla for the purpose of creating a more rounded appearance at the rear portion of the vehicle, further it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the tube with end caps as taught by Cipolla for the purpose of allowing the use of standardized extruded tubing, thus avoiding the need for specially molded element having closed ends. While Cipolla fails to teach the end caps as being plastic, plastic is very well known in the manufacturing arts for <sup>its</sup> ~~its~~ light weight and low cost, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the caps from a plastic to ensure closure to the tubing structure without undesirably increasing the weight thereof.

### Response to Comments

8. Applicant's comments, filed with the amendment, have been carefully considered. Applicant has argued that mechanical characteristics of the signal unit of Duerkob would teach away from a combination. The examiner does not agree, in that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, there has been no suggestion by the examiner that the structure of the casing of Duerkob be somehow combined with that of Hagen et al. Applicant continues, with the assertion that Duerkob's and Hagen et al.'s references are non-analogous, however it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

(Fed. Cir. 1992). In this case, both are clearly directed to the same problem solving area, namely the provision of additional signaling for a motor vehicle beyond the stock-provided signals.

Applicant is reminded that there is no requirement that a motivation to combine be set forth explicitly in the prior art references being combined. Rather, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)). The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

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Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

### Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

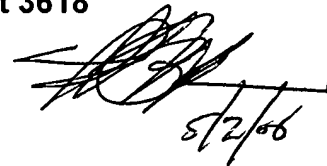
A response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
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Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**



5/2/06